

### **REMARKS**

This Amendment is responsive to the Office Action dated July 6, 2009. Applicant has amended independent claims 1, 19 and 20. Claims 1 and 4-20 remain pending.

#### **Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1, 4-14 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,480,745 to Nelson et al. (Nelson) in view of U.S. Patent Publication No. 2002/0046239 by Stawikowski et al. (Stawikowski) and further in view of U.S. Patent No. 6,385,589 to Trusheim et al. (Trusheim). The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Stawikowski and Trusheim, and further in view of Official Notice. Applicant respectfully traverses these rejections to the extent such rejections may be considered applicable to the amended claims. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

On page 10 of the Office Action, the Examiner continues to maintain the assertion that Trusheim teaches the translation web service of claim 1. More specifically, the Examiner noted that the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. The Examiner goes on to state that "Trusheim teaches translating the data from one format to another, therefore it teaches a structure necessary to configure the data in a plurality of formats." While Applicant does not acquiesce as to the Examiner's interpretation of any of the applied references, Applicant respectfully submits that Trusheim fails to teach or suggest the translation web service of amended claim 1.

The Examiner's argument improperly conflates the ability of hardware to convert data into one format, and the ability of hardware to convert data into multiple formats. Trusheim discloses a translator 31 that converts multiple input formats into an output format. Trusheim explicitly states that the output format is a standard format. For example, Trusheim states that the "primary function of translator 31 is to provide mapping of source files to standard data elements and code value names." See Trusheim, col. 8, lines 16-18. The standard data elements and code value names is a single output format; the user does not have the option to choose an output format.

Applicant continues to assert, and Examiner appears to concede, that Trusheim does not teach receiving a request for one of a plurality of formats, and returning medical data in the requested output format, as recited in claim 1 of the present application. Rather, Examiner's argument is that the hardware of Trusheim could be used in place of the claimed system. Despite the ability of Trusheim to convert one data format into another, it does not necessarily follow that the hardware of Trusheim is capable of receiving a request for one of a plurality of formats, and returning data in the requested output format. For example, the ability to receive a request for one of a plurality of formats may require additional processing capabilities for receiving the request, interpreting the request, and returning the requested format. Further, the ability to receive a request for one of a plurality of formats necessarily requires the capability of a user providing input.

The Examiner improperly relies on personal opinion in the assumption that the translator 31 can be used to receive a request for one of a plurality of formats, and return data in the requested output format. In fact, the disclosure of Trusheim is void of any such device or method of receiving user input and returning data in the requested output format. For example, as shown in Fig. 3 of Trusheim, the translator 31 is connected only to source data files 30 and a bus adapter program 35a. There is no apparatus present for receiving a desired format input. It is an oversimplification to assert that the hardware for data conversion to a single format can necessarily be used for receiving a request for one of a plurality of formats, and returning data in the requested output format.

Furthermore, Applicant has amended each of the independent claims to recite one or more devices configured to provide a plurality of web services including the recited translation web service. For example, independent claim 1, as amended, recites "one or more devices configured to provide a plurality of web services...wherein one of the web services is a translation web service having an input method configured to receive medical data in a first format and an output method configured to return the medical data in a plurality of output formats, wherein translation web service is further configured to receive a request for one of the plurality of output formats from an invoking application, and the output method is configured to return the medical data to the invoking application in the requested output format." The presence of the term "configured to" in the independent claims precludes the Examiner's assertion that these limitations are met by a device or system that is merely "capable of" performing the recited

functions. Instead, the claims must be interpreted to require one or more devices that have been configured to perform the recited functions, and thereby changed and made structurally different than a device that is merely capable of performing such functions. Such an interpretation is consistent with Federal Circuit precedent.<sup>1</sup>

Additionally, Applicant maintains that it would not have been obvious to one of ordinary skill in the art to have combined the disclosures of Nelson, Stawikowski, and Trusheim to arrive at the claimed invention. According to the Supreme Court, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”<sup>2</sup> It is impermissible hindsight for the Examiner to use the motivation stated in Applicant’s own disclosure as a blueprint to reconstruct the claimed invention from the prior art.<sup>3</sup> Rather, the Examiner’s rejection must be based on substantial evidence in the record demonstrated that the motivation for making the claimed invention resides in the prior art.

As described above, claim 1 recites a web service as a service for performing a data exchange function between the means for acquiring medical data and the means for handling medical data. Alternatively, the translator 31 of Trusheim is intended to convert files stored in various legacy data systems into a single, common format. Trusheim is not, however, related to a translation web service that performs a data exchange function between two means, as recited in claim 1. The Examiner suggests that the web server 50 of Trusheim being in communication with the translator 31 somehow supports the assertion that Trusheim includes a translation web service. Applicant respectfully disagrees. The translation services provided by the translator 31 are performed wholly within the translator 31. See Trusheim, Fig. 3. As described above, the translator 31 simply converts input data into a common output format. The fact that the translator 31 may have some attenuated connection to a web server does not transform the translator 31 into a translation web service.

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<sup>1</sup> See *In re Alappat*, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (a general purpose computer, or microprocessor, programmed to carry out an algorithm creates “a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions”); see also *In re Bernhart*, 163 USPQ2d 611, 615-16 (CCPA 1969) (“if a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged”).

<sup>2</sup> *KSR v. Teleflex*, 127 S.Ct. 1727 (2007).

<sup>3</sup> See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

Trusheim includes no teaching as to how to modify its teachings to comply with receiving any other sort of input data, e.g., medical data from a means for acquiring medical data, or a means for handling medical data as claimed in claim 1. Stawikowski also does not provide any disclosure regarding a method of modifying the teachings of Trusheim. Accordingly, even if one of ordinary skill in the art had found a reason to combine the applied references, one would not have arrived at the requirements of independent claims claim 1, 19 and 20.

For at least these reasons, independent claims 1, 19, and 20 are patentable over the applied references. Claims 4-18 depend from claim 1, and are therefore patentable for at least the same reasons as claim 1, and because they recite additional patentable features. In light of the deficiencies of the applied references with respect to the independent claims, Applicant generally declines to comment further with respect to the dependent claims. However, Applicant reserves the right to comment further on all of the pending claims in future responses and amendments.

Furthermore, Applicant respectfully traverses the Examiner's reliance on Official Notice for the rejection of claim 15. Applicant requests that the Examiner cite a reference demonstrating that it was well known in the information network arts to register a patient and/or medical device in a web service, and provide an objective reason for further modification of the cited references in view of the cited reference.

### CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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SHUMAKER & SIEFFERT, P.A.  
1625 Radio Drive, Suite 300  
Woodbury, Minnesota 55125  
Telephone: 651.286.8350  
Facsimile: 651.735.1102

By: 

Name: Jason D. Kelly  
Reg. No.: 54,213